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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/242,461	02/17/1999	FRANCIS THOMAS BOYLE	07164.0010	1092
9629	7590	12/03/2003	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP			COLEMAN, BRENDA LIBBY	
1111 PENNSYLVANIA AVENUE NW			ART UNIT	
WASHINGTON, DC 20004			PAPER NUMBER	
			1624	

DATE MAILED: 12/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

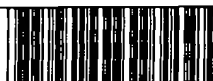
## Office Action Summary

Application No.  
**09/242,461**

Applicant(s)  
**BOYLE et al.**

Examiner  
**Brenda Coleman**

Art Unit  
**1624**



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Nov 10, 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-9, 13, and 18-22 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 8 is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 7, 9, 13, and 18-22 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

Claims 7-9, 13 and 18-22 are pending in the application.

This action is in response to applicants' amendment dated November 10, 2003. Claims 7 and 9 were amended.

The amendment filed November 10, 2003 under 37 CFR 1.116 in response to the final rejection **has been** considered and **entered**.

#### ***Response to Arguments***

Applicant's arguments filed November 10, 2003 have been fully considered with the following effect:

1. The applicant's amendments are sufficient to overcome the objections to the specification in the last office action, which are hereby **withdrawn**.
2. The applicant's amendments are sufficient to overcome the 35 U.S.C. § 112, first paragraph rejection of the last office action, which is hereby **withdrawn**.

#### ***Quayle Action***

This application is in condition for allowance except for the following formal matters:  
the presence of a typographical error in the specification and punctuation errors in claim 7.

#### ***Specification***

3. The disclosure is objected to because of the following informalities:

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- a) The amendment to the specification spanning page 2, line 6 to page 4, line 9 filed March 27, 2003 contains a typographical error, i.e. the definition of  $R^2$  where  $R^2$  is selected from the H;  $-C_{1-4}alkyl$ ;  $-COC_{1-4}alkyl$ ; and  $-COOC_{1-4}alkyl$ ; and  $-C_{1-3}alkylene-Ph$  optionally substituted on the phenyl ring by  $R^a$  **and or**  $R^b$ . It is believed that the applicants intended and/or. See the page 2 of the amendment filed March 27, 2003.

### *Claims*

4. Claim 7 and claims dependent thereon are objected to because of the following informalities:

- a) The definition of the substituents on the aryl or heterocycle within the definition of  $R^2$ ,  $R^3$ ,  $R^4$ , and  $R^5$  includes periods after the a, b, c and d labels.

#### **608.01(m) Form of Claims**

The claim or claims must commence on a separate sheet and should appear after the detailed description of the invention. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the Technology Center (TC) technical support staff. Each claim begins with a capital letter and ends with a period. **Periods may not be used elsewhere in the claims except for abbreviations.** See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(i).

- b) The definition of the substituents on the  $C_{1-4}alkyl$  within the definition of Y includes periods after the a, b, c, d and e labels.

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- c) The definition of the substituents on the C<sub>1-4</sub>alkyl within the definition of Y includes a moiety where the comma separating b and c is within the subscript.
- d) The definition of the substituents on the aryl and heterocycle within the definition of Y includes a two moieties which are not separated by punctuation, i.e. a comma is missing after CN.

Appropriate correction is required.

***Allowable Subject Matter***

- 5. Claim 8 is allowed. None of the prior art of record nor a search in the pertinent art area teaches the species of claim 8.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.


A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda Coleman whose telephone number is (703) 305-1880. The examiner can normally be reached on Mondays from 8:30 AM to 5:00 PM, on Tuesdays from 8:00 AM to 4:30 PM, on Wednesday thru Friday from 9:00 AM to 5:30 PM.

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The fax phone number for this Group is (703) 308-4734 for “unofficial” purposes and the actual number for **OFFICIAL** business is **308-4556**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink that reads "Brenda Coleman". The signature is fluid and cursive, with a long horizontal stroke at the end.

Brenda Coleman  
Primary Examiner AU 1624  
November 26, 2003